

REMARKS

Claims 1-6, 8, 9, and 33-41 were pending in the application. The non-final Office Action dated July 16, 2008 rejects claims 1-6, 8, 9, and 33-41.

This paper amends claim 1, cancels claims 8, and adds claims 42 and 43. Applicant is not conceding that the subject matter encompassed by claims 1 and 8 prior to this Amendment is not patentable over the art cited by the Examiner. Claim 1 was amended and claim 8 was cancelled in this Amendment to facilitate expeditious prosecution of the application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 1 and 8 as presented prior to this Amendment and additional claims in one or more continuing applications.

Claims 1-6, 9, and 33-43 are now pending in the application.

Objection to Drawings

The Office Action objects to drawings for not showing every feature of the invention specified in the claims, in particular the amended subject matter of claim 1 and the added subject matter of claims 33-41. Applicant herewith respectfully traverses the objection.

The applicant's invention, as claimed in the present application, recites a method of communicating with a user of a processor-based device over a network. The first sentence of 35 U.S.C 113 requires a drawing to be submitted upon filing "where such drawing is necessary for the understanding of the invention." (Underlining added.) "It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence)." (See MPEP 601.01(f) – underlining added). This implies that drawings are not always necessary.

Applicant is unsure of why drawings are necessary now, particularly because method claims have been a part of the application since the original filing. Moreover, the invention, as set forth in claims 1 and 33-41, does not require a drawing for the proper understanding of the invention – this is self-evident from the Examiner's office action. Therefore, applicant respectfully submits that amendment to the drawings is unnecessary, and respectfully request that the objection be withdrawn.

Claim Rejection under 35 U.S.C. §103

The Office Action rejects claims 1-3, 5, 6, 8, 9, 33, 34, 38, 40, and 41 under 35 U.S.C. §103(a) as being unpatentable over Malik (US Publication No. 2004/0078448) in view of Request for Comments: 2822, P. Resnick (Resnick), and further in view of Kalfas (U.S. Publication No. 2004/0199598). Applicant respectfully traverses the rejection.

Applicant's invention, as now set forth, in pertinent part, in representative claim 1, recites converting a synchronous communication between a first user and a second user into a body-less electronic mail message. The body-less electronic mail message has a subject line and lacks a message body capable of receiving message content. The subject line of the body-less electronic mail message contains at least one text message transmitted during the synchronous communication. In addition, the body-less electronic mail message is converted into a synchronous communications format that includes each text message contained in the subject line of the body-less electronic mail message. Thus, the applicant's invention performs communication conversions in both directions: from a synchronous communication to a body-less email message; and from a body-less email message to a synchronous communication format.

None of the cited references, whether taken alone or in combination, teaches or suggests converting a synchronous communication into a body-less email message and a body-less email message into a synchronous communication, as now set forth in the applicant's claimed invention. Granted, Malik shows a mechanism for converting IM chats into email messages (albeit, not into body-less email messages), yet Malik does not teach or suggest converting email messages, let alone body-less email messages, into IM chat messages.

As an aside, the office action fails to recognize the use and value of body-less email messages. Granted, Resnick teaches that an email message can exist without a message body, but Resnick does not appreciate that many, if not all, commercial email message systems require email messages to have a body, even though many email messages, in practice, are sent with a body but without body content. Nor do any of the cited references appreciate the cumulative storage gains associated with transmitting and storing body-less email messages. For instance, none of the other cited references, namely Malik, Kalfas, Yong, Zhang, or Eason, contemplate body-less email messages (i.e., email messages without a body capable of receiving content), let alone an email system that includes body-less email messages and email messages with body content, as now claimed in the applicant's claimed invention. The coexistence of body-less email with body-present email (i.e., traditional email), in conjunction with the converting of synchronous communications to body-less email and body-less email to synchronous communications, is unique to applicant's claimed invention. Therefore, applicant respectfully submits that the applicant's invention is patentable over the cited references, and requests that the rejection be withdrawn.

The Office Action also rejects claim 4 under 35 U.S.C. §103(a) as being unpatentable over Malik, Resnick, and Kalfas, and further in view of Whittle (US Publication No. 2005/0050462); claims 35-36 over Malik, Resnick, and Kalfas, and further in view of Yong (U.S. Patent No. 6,963,904); claim 37 over Malik, Resnick, and Kalfas, and further in view of Zhang (U.S. Patent No. 6,016,478); and claim 39 under 35 U.S.C. §103(a) as being unpatentable over Malik, Resnick, and Kalfas, and further in view of Eason (U.S. Publication No. 2005/0039028). Applicant respectfully traverses these rejections to the extent they are maintained against pending claims, as amended, because each of these claims is a dependent claim that depends directly or indirectly from patentable independent claim 1, and incorporates all of its limitations and, therefore, is patentable for at least this reason.

NEW CLAIMS

Newly added independent claims 42 and 43 are allowable as written because none of the cited references, whether taken alone or in combination, teaches or suggests converting a synchronous communication into a body-less email message and converting the body-less email message into a synchronous communication, or converting a body-less email message into a synchronous communication and converting the synchronous communication into a second body-less email message, as set forth in the applicant's claimed invention.

CONCLUSION

Applicant submits that this paper provides a response for all pending claims. Any absence of a reply to a specific rejection, issue, or comment, or to any taking of official notice or reliance on common sense, however, does not signify agreement with or concession of that rejection, issue, comment, taking of official notice, or reliance on common sense. In addition, because

the arguments made above are not exhaustive, there may be reasons for patentability of any or all pending claims that have not been expressed.

In view of the amendments and arguments provided herein, applicant submits that the application is in condition for allowance and requests early favorable action by the Examiner.

If the Examiner believes that a telephone conversation with the applicant's representative would expedite allowance of this application, the Examiner is cordially invited to call the undersigned at (508) 303-0932.

Respectfully submitted,

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